

REMARKS

Claims 8 to 14 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for accepting the Drawings and for acknowledging the foreign priority claim.

Claims 8 to 12 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Morsch, DE 3425235.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As to the assertions that the rotary sensor features are merely intended use, this is not so. The claim recites the features and structure as to a rotary sensor both in the preamble and in the body of the claim, so that the features are not merely an intended use.

The claims have been slightly rewritten as a grammatical matter, and have not been rewritten as to the rejections. Approval and entry are respectfully requested.

Any review of the applied reference makes plain it nowhere discloses or suggests an electronic circuit configuration for connecting at least one active rotary speed sensor of a vehicle via an assigned signal conditioning circuit to a control unit for further signal processing of a rotary speed signal, including: a normally closed switching element inserted into a circuit for a current supply of the active rotary speed sensor, the switching element being switchable into an open state via a detecting arrangement to detect an overvoltage in one of a first sensor line and a second sensor line to prevent an overvoltage that is damaging to the active rotary speed sensor.

In particular, the Morsch reference does not disclose nor suggest a *switching element that is switchable into an open state via a detecting arrangement to detect an overvoltage in one of a first sensor line and a second sensor line to prevent an overvoltage that is damaging to the active rotary speed sensor*. The Office Action relies upon the V-MOS transistor 2 as being the normally closed switching element, but the English Abstract of the applied reference specifically states that a disconnection controller (3, 6) drives the V-MOS transistor (2) into a completely blocked state when threshold switch (3) triggers because the upper limit value for the input voltage is exceeded. That is, the VMOS transistor is not a normally open element, as provided for in the context of the claimed subject matter.

Accordingly, claim 8 is allowable, as are its dependent claims.

Claim 14 includes features like those of claim 8, and is therefore allowable for essentially the same reasons.

As further regards the obviousness rejections, it is respectfully submitted that the cases of In re Fine, *supra*, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

It is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of

obviousness in rejecting [the] claims . . . under 35 U.S.C. Section
103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again,
there have been no such findings to establish that the features discussed above of the rejected
claims are met by the reference relied upon. As referred to above, any review of the
reference, whether taken alone or combined, makes plain that the reference simply does not
describe the features discussed above of the rejected claims.

Accordingly, claims 8 to 14 are allowable.

New claims 15 to 19 do not add any new matter and are supported by the present
application. Dependent claims 15 to 19 depend from claim 14 and include features like those
of dependent claims 9 to 13, which depend from claim 8. Accordingly, claims 15 to 19 are
allowable for the same reasons as claim 14.

Accordingly, claims 8 to 19 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 8 to 19 are allowable. It is
therefore respectfully requested that the rejections (and any objections) be withdrawn, since
all issues raised have been addressed and obviated. An early and favorable action on the
merits is respectfully requested.

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Respectfully submitted,

By: 

Gerard A. Messina
Reg. No. 35,952

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

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